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10/017,831	12/07/2001	Joseph A. Manico	83565SLP	5035

7590
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02/06/2007

EXAMINER

HANNETT, JAMES M

ART UNIT

PAPER NUMBER

2622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/017,831	Applicant(s) MANICO ET AL.	
	Examiner James M. Hannett	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-11 and 13-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-7,9 and 16-22 is/are allowed.
- 6) ☒ Claim(s) 1,10,11,13-15 and 23-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/5/2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 6/16/2006 have been fully considered but they are not persuasive. The applicant argues that the fact that the imaging system of Ueda et al teaches that the imaging system is movable using the depicted wheels does not indicate portability. The examiner disagrees with the applicant. Clearly the imaging system of Ueda et al was designed to have wheels because it was desirable to make the system movable. Furthermore, although this system is not small enough to be moved by hand, the examiner took Official Notice that it would have been notoriously obvious to one of ordinary skill in the art at the time the invention was made to reduce the size of the imaging system of Ueda et al in order to make it small enough to be carried by hand. The examiner asserts that Ueda et al discloses the claimed invention except for being hand held and portable. It would have been an obvious matter of design choice to make the imaging system of Ueda et al small enough to be carried by hand, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955). Furthermore, the examiner asserts that it has been held that making an old device portable or movable without producing any new and unexpected result involves only routine in the art. In re Lindberg, 93 USPQ 23 (CCPA 1952).

The applicant further argues that the examiners assertion that Figure 9 and Column 71, Lines 10-50 does not teach "that if the photo-shop is unable to perform all of the desired imaging services the images can be sent to a main photo-finisher" The examiner disagrees and asserts that although the reference to Column 71, Lines 10-50 by its self does not teach this

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limitation clearly, Figure 9 clearly depicts images being transferred from the photo-shop to a main photo-finishing center and back. This is further taught on Column 59, Lines 12-67.

The applicant argues that with regards to claims 10 and 11, the claims require a fulfiller or a sponsor provide a credit to a service provider that scanned the images. The applicant argues that the examiners taking of official notice that it was well known to have a fee splitting arrangement, is irrelevant since the claims are directed to payment of an incentive or credit which is not the same as fees. The examiner disagrees with the applicant and asserts that splitting a fee so that the service provider gets paid is viewed as equivalent to providing the service provider with an incentive or credit.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1: Claims 26 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by USPN

6,429,923 Ueda et al.

2: As for Claim 26, Ueda et al teaches on Column 1, Lines 26-35 and depicts in Figure 1, 2, and 9 a method of producing a print from a visual image (printing out images), comprising the steps of: transporting a portable imaging system to a first location; The examiner views the process of a company installing the photographic processing apparatus in a photo-shop as a service provider transporting a portable imaging system to a first location. Ueda et al teaches on

Column 36, Lines 43-60 that a customer will enter a photo-shop with photographs, negatives, and PC memory cards, etc with images on them which they want to be developed. This is viewed as the service provider receives the images to be digitized from a user at the first location. Ueda et al teaches on Column 35, Lines 37-42 that the service provider is equipped with a film scanner and a flat bed scanner, therefore the operator in the photo-shop scans the image at the first location (photo-shop) using the portable imaging system to produce a digital image. This is viewed by the examiner as scanning the hard copy document at the first location using the portable imaging system to produce a digital image. The system is viewed by the examiner to be portable as a result of the wheels depicted in Figure 3. Ueda et al further depicts in Figures (3 and 5) that the portable photofinisher (600) is provided with wheels (302). Although the specification of Ueda et al does not specifically discuss the wheels or when the photofinisher will be moved, It is clear from in Figures (3 and 5) that the photofinisher is inherently designed to be moved from a first location to a second location.

3: As for Claim 27, Ueda et al teaches on Column 1, Lines 26-35 and depicts in Figure 1, 2, and 9 a method of digitizing an image. The examiner views the process of a company installing the photographic processing apparatus in a photo-shop as a service provider transporting a portable imaging system to a first location. Ueda et al teaches on Column 36, Lines 43-60 that a customer will enter a photo-shop with photographs, negatives, and PC memory cards, etc with images on them which they want to be developed. This is viewed as the service provider receives the images to be digitized from a user at the first location. Ueda et al teaches on Column 35, Lines 37-42 that the service provider is equipped with a film scanner and a flat bed scanner, therefore the operator in the photo-shop scans the image at the first location (photo-shop) using

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the portable imaging system to produce a digital image. This is viewed as accessing the image to be digitized at the second location and scanning the image at the second location using the portable imaging system to produce a digital image. Ueda et al teaches on Column 36, Lines 32-60 and Column 37, Lines 34-50 that the scanned image is digitized and stored in memory. Furthermore, Ueda et al teaches generating an order request associated with the stored digital image.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4: Claims 1, 10, 11, 13-15, and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,429,923 Ueda et al.

5: As for Claim 1, Ueda et al teaches on Column 1, Lines 26-35 and depicts in Figure 1, 2, and 9 a method of digitizing an image, comprising the steps of: The examiner views the process of a company installing the photographic processing apparatus in a photo-shop as a service provider transporting a portable imaging system from a first location to a second location. Ueda et al teaches on Column 36, Lines 43-60 that a customer will enter a photo-shop with photographs, negatives, and PC memory cards, etc with images on them which they want to be developed. This is viewed as the service provider receives the images to be digitized from a user at the second location. Ueda et al teaches on Column 35, Lines 37-42 that the service provider is equipped with a film scanner and a flat bed scanner, therefore the operator in the photo-shop

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scans the image at the second location (photo-shop) using the portable imaging system to produce a digital image; Ueda et al teaches on Column 36, Lines 55-67 and Column 38, Lines 1-9 that the photo-shop operator will take credit card information and order request information from a customer, this is viewed as the service provider receives an order request associated with the digital image from the user. Furthermore, Ueda et al depicts in Figure 9 and teaches on Column 71, Lines 10-50 that if the photo-shop is unable to perform all of the desired imaging services the images can be transmitted to the main photo-finishing center or a truck will arrive at the photo-shop and pickup the images and bring them to the photo-finishing processing center. This is viewed as the service provider providing the digital images to a fulfiller (photo-finishing center) for fulfillment of the order request. The examiner views the process of a company installing the photographic processing apparatus in a photo-shop as a service provider transporting a portable imaging system from a first location to a second location. However, Ueda et al does not discuss the specifics of the size of the photographic processing apparatus and is silent as to if the device can be small enough to be hand held and small enough for the service provider to carry it by hand.

Official Notice is taken that it was notoriously well known in the art to reduce the size of image processing apparatus such as scanners to as small a size as possible. This is advantageous because it allows the device to take up less space and enables the device to be easily moved.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to reduce the size of the image processing apparatus in order to allow the device to take up less space and enable the device to be easily moved by hand.

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6: In regards to Claim 10, Ueda et al teaches on Column 1, Lines 26-35 and depicts in Figure 1, 2, and 9 a method of digitizing an image provided by a user comprising the steps of: The examiner views the process of a company installing the photographic processing apparatus in a photo-shop as a service provider transporting a portable imaging system to a first location. Ueda et al teaches on Column 36, Lines 43-60 that a customer will enter a photo-shop with photographs, negatives, and PC memory cards, etc with images on them which they want to be developed. This is viewed as the service provider receives the images to be digitized from a user at the first location. Ueda et al teaches on Column 35, Lines 37-42 that the service provider is equipped with a film scanner and a flat bed scanner, therefore the operator in the photo-shop scans the image at the first location (photo-shop) using the portable imaging system to produce a digital image; Furthermore, Ueda et al depicts in Figure 9 and teaches on Column 71, Lines 10-50 that if the photo-shop is unable to perform all of the desired imaging services the images can be transmitted to the main photo-finishing center (producing an image product from a digitized image). This is viewed as the service provider providing the digital images to a fulfiller (photo-finishing center) for fulfillment of the order request. Ueda et al teaches on Column 36, Lines 55-67 and Column 38, Lines 1-9 that the photo-shop operator will take credit card information and order request information from a customer, this is viewed as the service provider receives an order request associated with the digital image from the user. However, Ueda et al is silent as to who receives the payment and does not teach that the service provider (photo-shop) receives a credit from the photo-finishing center for some of the fee associated with producing an image product associated with the order request by agreeing to use the portable imaging system.

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Official notice is taken that it was common practice in the art at the time the invention was made for a convenience store which collects film cartridges and the processing facility which the store sends the film cartridges to in order to be developed, split the fee paid by the customer so that both parties can get paid.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to split the fee paid by the customer between the photo-shop and the photo processing facility so that both parties can get paid, and therefore stay in business.

The examiner views the process of a company installing the photographic processing apparatus in a photo-shop as a service provider transporting a portable imaging system from a first location to a second location. However, Ueda et al does not discuss the specifics of the size of the photographic processing apparatus and is silent as to if the device can be small enough to be hand held and small enough for the service provider to carry it by hand.

Official Notice is taken that it was notoriously well known in the art to reduce the size of image processing apparatus such as scanners to as small a size as possible. This is advantageous because it allows the device to take up less space and enables the device to be easily moved.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to reduce the size of the image processing apparatus in order to allow the device to take up less space and enables the device to be easily moved by hand.

7: As for Claim 11, Ueda et al teaches on Column 1, Lines 26-35 and depicts in Figure 1, 2, and 9 a method of producing an image product from an image comprising the steps of:

The examiner views the process of a company installing the photographic processing apparatus in a photo-shop as a service provider transporting a portable imaging system from a first location

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to a predetermined location (photo-shop); Ueda et al teaches on Column 36, Lines 43-60 that a customer will enter a photo-shop with photographs, negatives, and PC memory cards, etc with images on them which they want to be developed. This is viewed by the examiner as the service provider receiving the image from a user at the predetermined location (photo-shop);

Ueda et al teaches on Column 35, Lines 37-42 that the service provider is equipped with a film scanner and a flat bed scanner. Therefore the operator in the photo-shop scans the image at the predetermined location (photo-shop) using the portable imaging system to produce a digital image; Furthermore, Ueda et al depicts in Figure 9 and teaches on Column 71, Lines 10-50 that if the photo-shop is unable to perform all of the desired imaging services the images can be transmitted to the main photo-finishing center. This is viewed as the service provider providing the digital images to a fulfiller (photo-finishing center) for fulfillment of the order request.

Ueda et al teaches on Column 36, Lines 55-67 and Column 38, Lines 1-9 that the photo-shop operator will take credit card information and order request information from a customer, this is viewed as the service provider receives an order request associated with the digital image from the user. However, Ueda et al is silent as to who receives the payment and does not teach that the service provider (photo-shop) receives a credit from the photo-finishing center for some of the fee associated with producing an image product associated with the order request by agreeing to use the portable imaging system.

Official notice is taken that it was common practice in the art at the time the invention was made for a convenience store which collects film cartridges and the processing facility which the store sends the film cartridges to in order to be developed, split the fee paid by the customer so that both parties can get paid.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to split the fee paid by the customer between the photo-shop and the photo processing facility so that both parties can get paid, and therefore stay in business.

The examiner views the process of a company installing the photographic processing apparatus in a photo-shop as a service provider transporting a portable imaging system from a first location to a second location. However, Ueda et al does not discuss the specifics of the size of the photographic processing apparatus and is silent as to if the device can be small enough to be hand held and small enough for the service provider to carry it by hand.

Official Notice is taken that it was notoriously well known in the art to reduce the size of image processing apparatus such as scanners to as small a size as possible. This is advantageous because it allows the device to take up less space and enables the device to be easily moved.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to reduce the size of the image processing apparatus in order to allow the device to take up less space and enables the device to be easily moved by hand.

8: As for Claim 13, Ueda et al depicts in Figure 9 and teaches on Column 71, Lines 10-50 that if the photo-shop is unable to perform all of the desired imaging services the images can be transmitted to the main photo-finishing center. Therefore, the image product is produced at the second location (photo-finishing center) remote from the predetermined location (photo-store).

9: In regards to Claim 14, Ueda et al teaches on Column 35, Lines 37-42 that the service provider is equipped with a film scanner and a flat bed scanner. Therefore the operator in the photo-shop scans the image at the predetermined location (photo-shop) using the portable imaging system to produce a digital image.

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10: As for Claim 15, Ueda et al teaches on Column 36, Lines 43-60 that a customer will enter a photo-shop with photographs, negatives, and PC memory cards, etc with images on them which they want to be developed.

11: As for Claim 23, Claim 23 is rejected for reasons discussed related to Claim 1.

12: In regards to Claim 24, Claim 24 is rejected for reasons discussed related to claim 11.

13: As for Claim 25, Claim 25 is rejected for reasons discussed related to Claim 1.

Allowable Subject Matter

14: Claims 2-7, 9, 16-22 are allowed

The following is a statement of reasons for the indication of allowable subject matter: The prior art does not teach the method of transporting a portable imaging system to a first location; receiving a hardcopy document from a user at the first location, the hard copy document containing the visual image; scanning the hard copy document at the first location using the portable imaging system to produce a digital image; and transporting the portable imaging system to a second location remote from the first location. Furthermore, the prior art does not teach the method of sequentially transporting a portable imaging system from a first location; accessing the image to be digitized at the second location; scanning the image at the second location using the portable imaging system and storing the digital image in memory disposed in the portable imaging system and generating an order request associated with the stored digital image.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James M. Hannett whose telephone number is 571-272-7309. The examiner can normally be reached on 8:00 am to 5:00 pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on 571-272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James M. Hannett
Examiner
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JMH

January 30, 2007



TUAN HO
PRIMARY EXAMINER